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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,508	01/24/2002	Christian Vogt	L3669-01	4414

7590 10/28/2003
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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT PAPER NUMBER

1714

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,508

Applicant(s)

VOGT ET AL.

Examiner

Katarzyna Wyrozebski Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1201.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Objections

1. Claims 7-10, 14-15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 8 depends on multiply dependant claim 7. On the same token, claim 9 depends on improperly multiply dependant claim 8, multiply dependant claim 10 depends on improperly dependant claim 9, Claim 14 is multiply dependent claim depending on multiply dependant claim 13, multiply dependant claim 15 depends on multiply dependant claim 14. See MPEP § 608.01(n). Instead of not considering the claims at all, for more prompt prosecution of the application all dependent claims are treated as dependant on claim 1.

Applicants have submitted search from European patent office indicating X-references. Although the amendment to the claims, which included incorporating limitations of claim 4 into claim 1 overcame the X-reference, these references are hereby utilized in 103 rejections. In view of the preliminary amendment, claims 1-3 and 5-16 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over KLIER (DE 40 10 167) in view of NISHI (US 5,919,856).

The prior art of KLIER discloses composition for coating metal sheets, wherein the composition according to claims 1-3 comprises 10-30 wt % polyester, 7-22 wt % phenolic resin, 4-27 wt % thermoplastic resin, optional epoxy resin or amino resin and 30-70 wt % organic solvents.

Table (for example table 7, page 9) discloses polyester resin, phenolic resin, acid catalyst, wax, naphtha as solvent and butyl glycol.

Polyester resin according to the specification comprises monomers selected from phthalic acid, adipic acid, alzeic acid, sebacic acid. The polyol component of the polyester of KLIER comprises ethylene glycol, propylene glycol, butanediol, neopentyl glycol, trimethylol ethane and trimethylol propane (page 3, lines 40-50).

The phenolic resin of the prior art of KLIER is preferably a resole. The resole resin of KLIER is a polycondensation product of formaldehyde with phenolic component such as phenol, bisphenol A or substituted phenol (page 3, line 57-65).

Solvents in addition to the glycol and naphtha disclosed in example include aromatic solvents, aliphatic solvents and cycloaliphatic solvents (page 5, lines 1-3).

The wax from the Table 7 includes polyolefin wax, caruba wax, bees wax and linolein (page 5, lines 14-15).

The catalyst of the prior art of KRIEL includes acid catalyst which is further disclosed in page 5, lines 15-16.

The metal substrate onto which the coating can be applied can be aluminum or nickel among others (page 5, lines 32-34).

The difference between the present invention and the prior art of KLIER is a more specific content of the polyester resin, which exhibits the percentages of the monomers utilized in making the polyester resin.

With respect to the above difference, the prior art of NISHI discloses coating composition, which also utilizes polyester. The composition of NISHI is also applied to the metallic substrate as it is disclosed in the abstract of NISHI.

Table 1 of the prior art of NISHI and to be more specific example 2 (col. 10) discloses polyester that comprises following components: trimethylol propane in amount of 272 parts, phthalic acid in amount of 193 parts, adipic acid in amount of 170 parts, neopentyl glycol in amount of 18 parts and another diol in amount of 100 parts. For total of 753 parts, trimethylol propane is 36 %, phthalic acid is 25%, adipic acid is 22%, neopentyl glycol is 2.3% and diol is in amount of 13%. Although the total amount of trimethylol propane in the present invention is 1-10% and that of diol is 15-30%, altering the two monomers to be within the claimed ranges would have been obvious to one having ordinary skill in the art for the following reason. The specification of the prior art of NISHI, teaches that the amount of the diol can be within a range of 3-30 % of diol (col. 3, lines 50-51). On the same token, trimethylol propane is branching agents. One of ordinary skill in the art would know to add less of trimethylol propane depending on the degree of branching one would like to obtain.

The monomers of the prior art of NISHI are actually the same types of monomers that are disclosed in the prior art of KLIER. Utilizing them in various amounts such as in the prior art of NISHI would still afford a composition that can be utilized as a coating for metal substrates.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art to modify the polyester of NISHI as taught by the specification of the prior art and utilize so formed polyester in the composition of KLIER to obtain the claimed invention. Such

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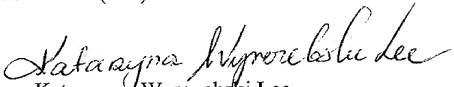
modification would result in polyester that can be utilized in the coating composition for metal substrates.

Note: In December 2003 the Patent Office will be changing location to Alexandria as a result of which phone numbers will be changed. The new phone number for the examiner of record will be 571-272-1127.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

October 20, 2003